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NOTICE OF ALLOWANCE AND FEE(S) DUE

7590

11/10/2010

David S. Resnick
Nixon Peabody LLP
100 Summer Street
Boston, MA 02110

EXAMINER

MARVICH, MARIA

ART UNIT

PAPER NUMBER

1633

DATE MAILED: 11/10/2010

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,963

06/21/2005

Menachem Rubinstein

057878-16

3232

TITLE OF INVENTION: PROMOTER TO IL-18BP, ITS PREPARATION AND USE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$300	\$0	\$1810	02/10/2011

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

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Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

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David S. Resnick
Nixon Peabody LLP
100 Summer Street
Boston, MA 02110

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

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nonprovisional

NO

\$1510

\$300

\$0

\$1810

02/10/2011

EXAMINER	ART UNIT	CLASS-SUBCLASS
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MARVICH, MARIA

1633

536-024100

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,

1 _____

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

2 _____

3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

☐ Issue Fee

☐ Publication Fee (No small entity discount permitted)

☐ Advance Order - # of Copies _____

4b. Payment of Fee(s); (Please first reapply any previously paid issue fee shown above)

☐ A check is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.

☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____

Date _____

Typed or printed name _____

Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 0 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Notice of Allowability	Application No.	Applicant(s)	
	10/530,963	RUBINSTEIN ET AL.	
	Examiner	Art Unit	
	MARIA B. MARVICH	1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to tan RCE fld 9/30/10.
2. ☒ The allowed claim(s) is/are 1,2,5-15, 17-19,34 and 36-50.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| <ol style="list-style-type: none"> 1. <input type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date <u>9/30/10</u> 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____. |
|---|--|

DETAILED ACTION

This action is in response to an RCE after allowance mailed 9/20/10. The allowance mailed 9/20/10 was in response to an after final amendment filed 9/9/10 which was entered and an after final amendment mailed 8/16/10 which was not entered.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/10 has been entered.

Claims 1, 2, 5-15, 17-19, 34 and 36-50 filed 9/9/10 are pending.

Applicants' amendments to the claims are sufficient to overcome the objections and the rejections under 35 USC 112, second paragraph in the Final Rejection mailed 3/16/10. As well, the amendment to limit the promoter to SEQ ID NO:1 as opposed to fragments thereof wherein SEQ ID NO:1 is operably linked to SEQ ID NO:5 at the 3' end of SEQ ID NO:1 is sufficient to overcome the rejection under 35 USC 103 over Novick et al (6,605,280) in view of Pance et al (FASEB J. (February 25, 2002), pages 631-633). Neither Novick et al nor Pance et al teach the full length promoter of SEQ ID NO:1. Novick et al is directed towards isolation of the IL-18BP protein wherein ancillary sequences associated with it correspond to a fragment of SEQ ID NO:1.

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Information Disclosure Statement

Two information disclosure statements filed 9/30/10 have been identified and the documents considered. The corresponding signed and initialed PTO Form 1449 has been mailed with this action.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in an interview with Leena Karttunen on 10/1/10.

The application has been amended as follows:

IN THE CLAIMS:

Claim 1. (Currently amended) An isolated DNA sequence comprising a functional human IL-18BP promoter sequence comprising ~~[[a]]~~ the nucleotide sequence of SEQ ID NO: 1 and further comprising ~~operably linked at the 3' end of the promoter sequence to~~ SEQ ID NO: 5 operably linked to the 3' end of SEQ ID NO:1.

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Claim 2. (Currently amended) An isolated DNA sequence comprising a functional human IL-18BP promoter comprising ~~[[a]]~~ the nucleotide sequence of SEQ ID NO: 1 and further comprising operably linked at the 3' end of the promoter sequence to SEQ ID NO: 5 operably linked to the 3' end of SEQ ID NO:1 and wherein the promoter is mutated at one or more AP1 sites present in the silencer element present in SEQ ID NO: 1.

Claim 7. (Currently amended) The isolated DNA sequence according to claim 1, further ~~containing~~ comprising a gene operatively linked to the isolated DNA sequence.

Claim 11. (Currently amended) The isolated DNA sequence according to claim 9, wherein the heterologous gene encodes a protein selected from an interferon-beta, a TNF, an erythropoietin, a tissue plasminogen activator, a granulocyte colony stimulating factor, a manganese-superoxide 41 dismutase, an immunoglobulin, ~~[[or a]]~~ an immunoglobulin fragment ~~thereof~~, a growth hormone, an FSH, an hCG, an IL-1 8, an hsLDLR and a TNF receptor binding protein~~[[s]]~~.

Claim 17. (Currently amended) A recombinant virus vector which comprises a portion of the virus genomic nucleic acid, a DNA fragment ~~encoding~~ comprising a gene of interest and a DNA fragment comprising the DNA sequence according to claim 1, operably linked to the gene of interest.

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Claim 18. (Currently amended) The recombinant virus vector according to claim 17, wherein the gene of interest encodes a protein selected from an interferon-beta, a TNF, an erythropoietin, a tissue plasminogen activator, a granulocyte colony stimulating factor, a manganese-superoxide dismutase, an immunoglobulin, ~~[[or a]]~~ an immunoglobulin fragment ~~thereof~~, a growth hormone, an FSH, an hCG, an IL-1 8, an hsLDLR and a TNF receptor binding protein~~[[s]]~~.

Claim 38. (Currently amended) The isolated DNA sequence according to claim 2, further ~~containing~~ comprising a gene operatively linked to the isolated DNA sequence.

Claim 43. (Currently amended). ~~[[The]]~~ A vector comprising the DNA sequence according to claim 2.

Claim 44. (Currently amended). ~~[[The]]~~ An isolated host cell comprising ~~[[a]]~~ the vector according to claim 43.

Claim 47. (Currently amended) A recombinant virus vector which comprises a portion of the virus genomic nucleic acid, a DNA fragment ~~encoding~~ comprising a gene of interest and a DNA fragment comprising the DNA sequence according to claim 2, operably linked to the gene of interest.

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Claim 48. (Currently amended) The recombinant virus vector according to claim 47, wherein the gene of interest encodes a protein selected from an interferon-beta, a TNF, an erythropoietin, a tissue plasminogen activator, a granulocyte colony stimulating factor, a manganese-superoxide dismutase, an immunoglobulin, ~~[[or a]]~~ an immunoglobulin fragment ~~thereof~~, a growth hormone, an FSH, an hCG, an IL-1 8, an hsLDLR and a TNF receptor binding protein~~[[s]]~~.

Conclusion

The claims have been renumbered in the following order: claims 1, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 17, 18, 19, 34, 2, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50.

The amendments have been made in claim 1 and 2 to more clearly indicate the claimed invention. Specifically, the recitation that the promoter comprises a nucleotide sequence of SEQ ID NO: 1 means that only a dinucleotide need be included. However, the invention is based upon the linkage of the entirety of SEQ ID NO:1 to SEQ ID NO:5. The second amendment has been made to clarify that "the 3' end" corresponds to SEQ ID NO:1.

The amendment to claims 7, 17 and 38 have been made due to a preference for "comprising" over "containing" in the context of reciting a component for which the open language correlating with comprising matches.

The amendment to claim 11, 18 and 48 have been made to place the group of proteins in proper Markush listings as use of or in the middle of the claim offsets what the list entails.

Claims 43-45 were corrected to use the proper article. When designating previously recited limitations, "the" is proper and "a" or "an" when referring to new limitations.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIA B. MARVICH whose telephone number is (571)272-0774. The examiner can normally be reached on M-F (7:00-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach, PhD can be reached on (571)-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Maria B Marvich, PhD
Primary Examiner
Art Unit 1633

/Maria B Marvich/
Primary Examiner, Art Unit 1633